

REMARKS

Claims 133 – 139 and 152 – 159 are currently pending in the Application. Independent claims 133 and 153 have been amended. Support for the amendments to claims 133 and 153 may be found, for example, in the specification at paragraphs 92 – 93, 135, 165 – 178 and 233 – 239 and Fig. 3. Accordingly, no new matter has been added to the application by the foregoing amendments.

References made herein to the “specification” refer to the Substitute Specification submitted with the Declaration of Douglas J. Ryder on July 25, 2003.

Entry of Rule 116 Response

Entry of the amendment herein is respectfully requested because such amendment leaves the application in condition for allowance without entering any new matter. Also, during the telephone Interview, the Examiner agreed to allow entry of the claim amendments submitted herewith. The response does not raise any new issues that would require further consideration and/or search, since all features of the pending claims were previously presented, considered and presumably searched. The Amendment thus resolves all issues raised by the Examiner in the Final Office Action and discussed with the Examiner during the Interview. The Amendment does not result in a net addition of claims to the application, and no new matter has been added to the application by the Amendment. Accordingly, **Applicants respectfully request that the Amendment After Final be entered in accordance with 37 CFR §1.116 and MPEP 714.13.**

Examiner Interview

Applicant and the undersigned thank Examiner Rhetta for the courtesies extended during a phone Interview conducted on December 13, 2010, to discuss the present application and Office Action. During the Interview, the 35 U.S.C. § 101 rejection raised by the Board of Patent Appeals and Interferences in a Decision dated August 27, 2010 and 35 U.S.C. § 101 rejection raised by the Examiner in the Final Office Action were discussed.

As a result of the Interview, the Examiner acknowledged Applicants' concerns as to the propriety of the rejection of claims 133 – 139 and 152 – 159 under 35 U.S.C. § 101. The Examiner explained her position on this issue and suggested that Applicants amend independent claims 133 and 153 to recite “by a computer” in the “generating” elements. The Examiner agreed that such an amendment would place the claims in condition for allowance and assured Applicants that such an amendment would be entered after final. Applicants suggested that the amendment be entered via Examiner’s Amendment. However, the Examiner felt that such amendment would be better suited in an amendment after final. Applicants have therefore incorporated the Examiner’s suggested amendment into each of the independent claims (claims 133 and 153) and respectfully submit that all claims are in condition for allowance.

Claim Rejection – § 101

Claims 133 – 139 and 152 – 159 have been rejected under 35 U.S.C. § 101. The Examiner contends that, “a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus” or (2) transform the underlying subject matter (such as an article or materials) to a different state of things.” (Office Action, page 2 (citations omitted)). Applicants respectfully traverse this rejection.

As discussed with the Examiner during the Interview, the Examiner stated that amending item (e) of independent claims 133 and 153 to recite “generating, by a computer, inferred consumer characteristics ...” would alleviate the Examiner’s concerns and place the Application in condition for allowance. Although not agreeing with the Examiner that such amendments are necessary, independent claims 133 and 153 have been amended in the specific manner requested by the Examiner. As such, the Examiner’s rejection has been overcome, and claims 133 and 153, and all claims dependent thereon, are in condition for allowance. To the extent that such rejection is applied or relied on in any future proceeding related to this application, for at least the reasons set forth below, Applicants maintain that the rejection is in error.

Initially, Applicants incorporate by reference the arguments presented in Applicants’ Amendment filed October 27, 2010. Applicants respectfully submit that these

arguments alone show that the claims should not have been rejected under 35 U.S.C. § 101 in the manner articulated by the Examiner in the Final Office Action. Such arguments also demonstrate that the claims satisfy the machine or transformation test relied upon by the Examiner herein, despite the fact that, as described below, the Examiner has improperly applied the machine or transformation test.

Applicants regard the current 35 U.S.C. § 101 rejection to be improper as being directly contrary to both the U.S. Supreme Court’s ruling in *Bilski v. Kappos*, (Supreme Court 2010) (08-964) and the USPTO’s *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos* (75 FR 43922) (2010-07-27). The Examiner’s sole rejection notes that the claims “**must**” meet the machine or transformation test; the Examiner provides no additional analysis or basis for this rejection. The Supreme Court is explicit that the “machine or transformation test” being used as “the sole test … violates” the patent statutes. (*Bilski* at 6). The USPTO’s Interim Guidance quotes this portion of *Bilski* and recite a comprehensive methodology for evaluating claims which is not based on the machine or transformation test. (*Interim Guidance* at 43924 – 43928). As such, the Examiner’s rejection is improper.

In view of the foregoing misstatement and misapplication of law, to the extent that (a) the present amendments are not entered; or (b) the next action with regard to this application is not a Notice of Allowance, Applicants hereby request a new Office Action properly addressing the claims and a restart of the period for reply running from the mail date of the corrected Office Action as required by MPEP 710.06. “Where … an Office action contains some other error that affects applicant’s ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by the applicant.” (MPEP 710.06). In view of the Examiner’s explicit statement that a Notice of Allowance would be forthcoming as a result of the above amendments, Applicants believe that a new Office Action will not be necessary.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application, including claims 133 – 139 and 152 – 159, is in condition for allowance. Reconsideration and withdrawal of the rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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